

REMARKS

In the final Office Action, the Examiner continued to withdraw claims 21-25 from consideration; rejected claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over European Patent Application No. 0,928,680 (EP '680); rejected claim 19 under obviousness-type double patenting over claim 32 of U.S. Patent No. 6,457,504 (the '504 patent) in view of EP '680; and rejected claim 20 under obviousness-type double patenting over claim 32 of the '504 patent EP '680 and claim 20 of the '504 patent.

Withdrawn Claims 21-25

At the outset, Applicant continues to traverse the Examiner's restriction requirement of October 6, 2003, but, as noted in Applicant's Request for Reconsideration dated June 30, 2004 (the "June 30 Reply"), Applicant acknowledges the Examiner's willingness to consider rejoinder of withdrawn claims 21-25 which incorporate allowable subject matter (see Office Action of April 1, 2004 at page 2). As discussed in greater detail below and for reasons set forth in the June 30 Reply, claim 17, from which claims 21-25 either directly or indirectly depend, is deemed allowable. Accordingly, upon allowance of claim 17, Applicant respectfully requests that claims 21-25 be rejoined and allowed along with dependent claims 18-20.

Rejection of Claims 17 and 18 Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the Examiner's rejection of claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over EP '680. Claim 17, for example, is not obvious over EP '680 because the document fails to teach or suggest each and every element of the claim. In particular, EP '680 at least fails to teach or suggest the claimed combination, as recited in claim

17, including first, second, and third circumferentially-inextensible annular inserts (hereinafter “annular inserts”).

In the final Office Action, the Examiner states that EP ‘680 is “applied for the same reasons as set forth in paragraph 6 of the Office action mailed April 1, 2004.” Final Office Action at page 2. Accordingly, the Examiner apparently continues to maintain that EP ‘680 discloses a “first circumferentially inextensible annular insert 27” and a “second circumferentially inextensible annular insert 28” (April 1 Office Action at page 6), which, as shown in Fig. 10, is provided between first carcass ply 3 and second carcass ply 31. The Examiner also apparently continues to concede, however, that EP ‘680 fails to disclose the claimed combination including a third annular insert (see Office Action at page 6), but argues that the claimed third annular insert would have been obvious.

Specifically, the Examiner apparently continues to rely on portions of EP ‘680 describing an “alternative solution” whereby the second annular insert 28 is provided “subsequently to formation of the second carcass ply 31” (EP ‘680 at paragraph 0110). In which case, according to the Examiner, second annular insert 28 would be provided outside second carcass ply 31, such that portions of second carcass ply 31 would be provided between second annular insert 28 and first annular insert 27. Thus, as argued by the Examiner in the Final Office Action, “one of ordinary skill in the art would have a reasonable expectation of success in providing the circumferentially inextensible annular insert in both alternative locations to further anchor the tire to the rim and to further counteract bead rotation.” Final Office Action at page 2. Applicant respectfully disagrees for reason discussed in the June 30 Reply, as well as those presented below.

Although the “alternative solution” of EP ‘680 teaches providing the second annular insert outside second carcass ply 31, the reference expressly teaches that *only* first annular insert 27 would be attached to filling body 29 in this instance (“In accordance with a possible alternative solution, accomplishment of each annular structure 4 may first involve formation of the first annular insert 27 *alone* joined to the filling body 29,” emphasis added, EP ‘680 at paragraph 0110). Accordingly, contrary to the Examiner’s assertions, one of ordinary skill would not attach an additional annular insert to filling body 29 if the second annular insert 28 were provided outside second carcass ply 31. Thus, EP ‘680 teaches away from Applicant’s claimed combination including first, second, and third annular inserts, as recited in claim 17.

Moreover, as noted in Applicant’s specification, the second and third annular inserts (i.e., the “two annular inserts” discussed in the specification at page 5, lines 5-10), achieve “surprising advantages” by “grip[ping] the terminal edges belonging respectively to the segments of one of said series.” *Id.* In addition, the specification teaches that “[t]he presence of the circumferentially inextensible annular insets 23, 24 and 26, ... provides an excellent ‘bond’ with the filiform elements 15 belonging to the different series of strip-like segments.” Specification at page 20, lines 7-11. Thus, in light of such unexpected results, Applicant respectfully submits that claim 17 would not have been obvious in view of the Examiner’s proposed modification of EP ‘680.

Further, Applicant advises that if EP ‘680 were modified in the manner proposed by the Examiner, the resulting combination could create undesired stresses in the carcass. Accordingly, one of ordinary skill would not be motivated to modify EP ‘680 as suggested by the Examiner for this reason also.

In light of the above-described deficiencies of EP '680, Applicant submits that claim 17 is allowable over the applied reference, and claim 18 is allowable at least due to its dependence from claim 17.

Double Patent Rejections of Claims 19 and 20

Applicant respectfully traverses the Examiner's double patenting rejection of claim 19 over claim 32 of the '504 patent in view of EP '680, as well as the double patenting rejection of claim 20 over claim 32 of the '504 patent in view of EP '680 and claim 20 of the '504 patent.

Without addressing points raised by Applicant in the June 30 Reply, the Examiner maintained the above-noted double patenting rejections (see Final Office Action at page 3). Applicant continues to disagree with the positions taken by the Examiner in the April 1 Office Action as well as the Final Office Action, and requests that the double patent rejections of claims 19 and 20 be withdrawn for reasons set forth in the June 30 Reply.

Claim Scope

In discussing the specification, claims, abstract, and drawings in this Request for Reconsideration, it is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicant believes that Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Summary

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: _____

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